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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,087	12/16/2005	Hiroshi Yahata	92478-8300	2444
53044 7590 06/10/2008 SNELL & WILMER L.L.P. (Matsushita) 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626				
EXAMINER				
WENDMAGEGN, GIRUMSEW				
ART UNIT		PAPER NUMBER		
2621				
MAIL DATE		DELIVERY MODE		
06/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/561,087

**Applicant(s)**

YAHATA ET AL.

**Examiner**

GIRUMSEW WENDMAGEGN

**Art Unit**

2621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7, 13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 1/31/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

1). It is noted that this application SN 10/561,087 is filed by four applicants, Yahata, Hiroshi; McCrossan, Joseph; Okada, Tomoyuki and Ikeda, Wataru. The declaration of inventors McCrossan, Joseph; Okada, Tomoyuki and Ogawa, Tomoki under 37 CFR \$1.131 may show reduction to practice of the invention of the Wo 2004/098193 A2, but not this application SN 10/561,087. In order to establish reduction to practice or conception with due diligence, the declaration of the other two inventors Yahata, Hiroshi and Ikeda, Wataru are required or the showing as required by MPEP.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim7, 13 and 15** is rejected under 35 U.S.C. 102(e) as being anticipated by Okada et al (Pub. No. WO 20041098193).

Regarding claim7, 15, A reproduction apparatus for reproducing a digital stream generated by multiplexing a video stream and a graphics stream, comprising: a video decoder operable to decode the video stream to generate a moving picture (see

figure26 video decoder); and a graphics decoder operable to decode the graphics stream to generate graphics, wherein, upon reading control information in the graphics stream, the graphics decoder transfers graphics which has been generated by decoding graphics data that precedes the control information in the graphics stream to a plane memory, based on the control information(see figure 26 graphics decoder and page44 line 4-6).

Regarding claim13, method of recording onto a recording medium, comprising the steps of: generating application data; and recording the application data to the recording medium, wherein: the application data includes a digital stream generated by multiplexing a video stream and a graphics stream (see page3 line11-22); the graphics stream is a sequence of a plurality of packets which include a packet containing control data (see page3 line11-22); and he control data indicates that graphics data contained in a preceding packet in the sequence is to be displayed at a predetermined time in a state of being overlaid on the video stream (see page5 paragraph 0092).

The applied reference has a common inventor(s) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIRUMSEW WENDMAGEGN whose telephone number is (571)270-1118. The examiner can normally be reached on 7:30-5:00, M-F, all Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Girumsew Wendmagegn/  
Examiner, Art Unit 2621

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621

